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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,911	12/04/2003	Maxime Lampilas	FRAV2002/0034US NP	7536

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/727,911

Applicant(s)

LAMPILAS ET AL.

Examiner

Brenda L. Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-41 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Claims 1-41 are pending in the application.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 9, 11-18, 20, 22 and 40, drawn to the compounds, compositions, process of preparing and method of use of the compounds of formula (I) where X is -C(O)-O- and n is 1, classified in class 546, subclasses 89+ and 115+.
- II. Claims 1, 3-6, 9, 11-18, 20, 22 and 40, drawn to the compounds, compositions, process of preparing and method of use of the compounds of formula (I) where X is -C(O)-O- and n is 2, classified in class 540, subclass 581+.
- III. Claims 1-6, 9, 11-18, 20, 22 and 40, drawn to the compounds, compositions, process of preparing and method of use of the compounds of formula (I) where X is -C(O)-O-CH<sub>2</sub> and n is 1, classified in class 544, subclass 63.
- IV. Claims 1, 3-6, 9, 11-18, 20, 22 and 40, drawn to the compounds, compositions, process of preparing and method of use of the compounds of formula (I) where X is -C(O)-O-CH<sub>2</sub> and n is 2, classified in class 540, subclass 488.
- V. Claims 1-23, 40 and 41, drawn to the compounds, compositions, process of preparing and method of use of the compounds of formula (I) where X

is -C(O)-NR<sub>8</sub>- and n is 1, classified in class 546, subclasses 81+ and 121+.

- VI. Claims 1, 3-9, 11-18, 20, 22 and 40, drawn to the compounds, compositions, process of preparing and method of use of the compounds of formula (I) where X is -C(O)-NR<sub>8</sub>- and n is 2, classified in class 544, subclasses 249+ and 282.
- VII. Claims 1-6, 8, 9, 11-18, 20, 22 and 40, drawn to the compounds, compositions, process of preparing and method of use of the compounds of formula (I) where X is -C(O)-NR<sub>8</sub>-CH<sub>2</sub> and n is 1, classified in class 544, subclasses 249+ and 282.
- VIII. Claims 1, 3-6, 8, 9, 11-18, 20, 22 and 40, drawn to the compounds, compositions, process of preparing and method of use of the compounds of formula (I) where X is -C(O)-NR<sub>8</sub>-CH<sub>2</sub> and n is 2, classified in class 540, subclass 556.
- IX. Claims 1-6, 8, 9, 11-18, 20, 22 and 40, drawn to the compounds, compositions, process of preparing and method of use of the compounds of formula (I) where X is -C(O)-NR<sub>8</sub>-O- and n is 1, classified in class 544, subclass 68.
- X. Claims 1, 3-6, 8, 9, 11-18, 20, 22 and 40, drawn to the compounds, compositions, process of preparing and method of use of the compounds of formula (I) where X is -C(O)-NR<sub>8</sub>-O- and n is 2, classified in class 540, subclass 556.

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- XI. Claims 24-39, drawn to the intermediate compounds of formulae (II), (III), (IV), (V), (VI), (VII), (VIII) and (VIII') where n is 1, classified in class 546, subclasses 112+ and 184+.
- XII. Claims 24-39, drawn to the intermediate compounds of formulae (II), (III), (IV), (V), (VI), (VII), (VIII) and (VIII') where n is 2, classified in class 540, subclasses 576+.

The inventions are distinct, each from the other because of the following reasons:

Groups I-X are directed to structurally dissimilar compounds such that the variable core created by the varying definitions of X and n in formula (I) do not belong to a recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the others, for example a 2,5-methano-1H-2,4-diazepine compound is different from a 1,6-diaza-bicyclo[3.2.1]octane-7-one compound, a 6-oxa-1-aza-bicyclo[3.2.1]octan-7-one compound, a 3-oxa-1-aza-bicyclo[3.3.1]nonan-2-one, etc. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structures as functional equivalents of each other. The mere fact that there is a single similarity is not in itself a significant reason to render the whole embodiment obvious.

Inventions I-X and XI-XII are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this

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relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful to prepare other substituted bicyclic and tricyclic ring systems and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

If one of Groups XI-XII is elected further restriction may be required.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Brenda L. Coleman  
Primary Examiner Art Unit 1624  
January 21, 2006